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08/187,543 01/28/94 TOMITA

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THOMAS, J. EXAMINER

24M1/0325

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ART UNIT PAPER NUMBER

2411

DATE MAILED: 03/25/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11/22/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-39 are pending in the application.

Of the above, claims 4-10, 12, 19-20, 23-30, and 32-39 are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-3, 11, 13-18, 21-22, and 31 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

***Notice to Applicant***

1. This correspondence is in response to the election filed 11/22/95 (Paper No. 10).

***Election/Restriction***

2. Applicant's election with traverse of claims 1-3, 11, 13-18, and 21-22 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the election requirement was imposed on the basis of groupings of claims, rather than by identifying disclosed species, to which claims are restricted (MPEP 809.02(a)). This is not found persuasive because the election requirement was imposed on the basis that each species within its respective grouping of claims (Groups I-V) is patentably distinct from the other (See MPEP §§ 806.04(h) and 808.01(a)). If Applicant wishes to dispute this issue, it is respectfully requested that Applicant clearly indicate within the record that Applicant does not consider the species designated by the Examiner to be patentably distinct from each other.

Further it is noted that MPEP § 809.02(a) states that "[i]f the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted."

As per Applicant's arguments that the Examiner's delineations of the species is inconsistent and contradictory, since they are not clearly or distinctly drawn, the Examiner

submits the following:

(i) As per the first example regarding claim 17/11, the Examiner respectfully contends that it is clear that claim 17/11 properly belongs in Group II rather than in Group V, since Group V is specifically drawn to services provided to the user via a communication circuit (such as software services recited in exemplary claim 28). Since claim 17/11 is drawn to merely storing a list of generic "services" (and NOT specifically "software services" or "services on a communication circuit") within a point notification means, rather than the providing of services, it clearly falls within Group II (i.e., limitations on the point notification means) rather than in Group V.

(ii) As per the second example regarding claim 31/1, the Examiner agrees with Applicant that claim 31/1 is drawn more to the Group II species rather than the Group IV species, and respectfully submits that this was an inadvertent or typographical error made by the previous Examiner of record. Any inconvenience on Applicant's part is regretted, and further, as of the current Office Action, claim 31/1 will be considered as elected along with claims 13-18, and 21-22 as comprising Applicant's elected group of claims (Group II, Subgroup A).

(iii) As per Applicant's third example, with respect to claim 34/30, the Examiner respectfully submits that since claim 34 depends on claim 30 which clearly recites the "provision of software services", it is readily apparent that claim 34/30 rightfully belongs in Group IV.

(iv) As per Applicant's remarks regarding claim 39/1, Examiner concedes that claim 39/1 is drawn more to the Group III species rather than the Group I species, and respectfully submits that this was merely an inadvertent or typographical error made by the previous Examiner of record. Any inconvenience on Applicant's part is regretted.

Thus, aside from the inadvertent or typographical errors noted in items (ii) and (iv) above (for which Applicant appears to have correctly identified or placed any detectable errors despite the "confusing" or "contradictory" species designations by the Examiner), it is respectfully submitted by the Examiner that the previously made election requirement is not improper.

In conclusion, the requirement is still deemed proper and is therefore made FINAL.

3. Claims 4-10, 12, 19-20, 23-30 and 32-39 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 10.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the

time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 1-3, 11, 13-18, 21-22, and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over Girouard et al. (4,892,346).

(A) As per claim 1, Girouard discloses an interactive mall promotion network system comprising a magnetic stripe card reader, a bar code reader, monitor, printer, and an input device (Girouard; fig. 1). The system includes a promotions for frequent shoppers or customers (Girouard; col. 4, lines 25-35, col. 18, line 34 to col. 23, line 37). Girouard teaches counts are credited to customer based on the frequency of transactions or visits (Girouard; figure 56; col. 18, line 64 to col. 19, line 5). Girouard system comprises an acceptance means, a retrieval means, an update means, and an award means (Girouard; col. 24, lines 19-34) which substantially function in the same manner as Applicant's point issue means and point accumulation means. As per customer identification means, Girouard teaches the use of magnetic or bar code cards that are unique to each customer (Girouard; col. 4, lines 3-15 and fig. 58). As per point

notification means, Girouard teaches displaying frequent shopper status on a monitor to the customer (Girouard; col. 19, lines 31-35).

Girouard does not specifically teach the notification of customer counts or points prior to the customer carrying out a transaction. However, this would have been obvious to one of ordinary skill in the art at the time of the invention to modify Girouard's system to enable the display of frequent shopper status to the customer prior to any transaction by the customer with the motivation of enabling the customer to review his status so as to give further flexibility and choice to the customer in deciding how he or she wishes to proceed (i.e., whether to redeem his current counts or to continue accumulating more counts).

(B) As per claim 2-3, it is readily apparent that Girouard terminal which is located within the mall must be turned on in order to provide customer notifications (Girouard; col. 1, lines 21-44).

(C) As per claims 11 and 31, Girouard teaches a plurality of multi-media devices and communications circuits (Girouard; col. col. 5, lines 15-50 and figs. 2-5).

(D) Claims 13-16 are drawn to displaying the point notifications for a customer in the form of color graphs. Girouard clearly teaches the use of graphics generation on his computer (Girouard;

col. 5, lines 15-50). One having ordinary skill in the art at the time of the invention would have found it obvious to utilize graphs with the motivation of depicting relevant information in a graphical, easily recognizable, and visually appealing format on a well-known, readily available, and versatile apparatus.

(E) As per claims 17-18, Girouard teaches a frequent shopper set-up routine and a counts set-up routine which stores the conditions for counts and credits within Girouard system (Girouard; col. 18, line 34 to col. 19, line 5).

(F) As per claim 21, Girouard discloses accepting participant information via a card reader (24), touch screen (28) or keyboard (30). The participant information is written to and stored within the enrollment file, wherein each record includes the enrollee's name, address, city, state, zip code, phone and country (Girouard; col. 17, lines 50-59; col. 18, lines 6-10 and lines 15-20; and figures 39, 40, and 42). In addition, Girouard discloses a direct mail campaign which distributes magnetic or bar code cards to selected customers in the geographic vicinity of a retail mall or similar shopping area (Girouard; col. 4, lines 7-10). Girouard clearly establishes that such mailing is done in order to attract customers to and promote the popularity of his Mall Promotion Network system (Girouard; col. 4, lines 3-15). Further, since Girouard utilizes selected customers for his direct mail campaign, and not merely customers at random, it is

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readily apparent that the mail sent to such customers would include names and addresses.

(G) As per claim 22, Girouard teaches displaying frequent shopper status on a monitor to the customer (Girouard; col. 19, lines 31-35).

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches systems and methods for awarding credits or purchase records as well as for attracting shoppers to mall outlets and evaluating consumer responses to broadcast transmissions.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Thomas, whose telephone number is (703) 305-9588. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiners' supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-9564 or (703) 305-9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

J.T.  
Joseph Thomas  
March 1, 1996

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER  
GROUP 2400